

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESEARCH IN MOTION CORP. and
RESEARCH IN MOTION LTD.

Petitioner

v.

MULTIMEDIA IDEAS LLC

Patent Owner

Case IPR2013-00036 (JL)
Patent 6,871,048

Before JAMESON LEE, KEVIN F. TURNER, and JONI Y. CHANG,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

BACKGROUND

Petitioner Research in Motion Corp. and Research In Motion Ltd. (RIM) petitioned on October 30, 2012 (Paper 1), for *inter partes* review of claims 1-12 of Patent 6,871,048 ('048 patent), and filed a corrected petition on November 6, 2012 (Paper 7), pursuant to 35 U.S.C. §§ 311 et seq. The patent owner, MobileMedia Ideas LLC (Mobilemedia), filed a preliminary response on February 7, 2013, under 37 C.F.R. § 42.107(b). (Paper 14.) We have jurisdiction under 35 U.S.C. § 314.

The '048 patent was the subject of a request for *ex parte* reexamination filed on January 5, 2012. That request was denied by examiners on April 3, 2012. (Ex. 1009.) Some of the references relied on by petitioner here were before the examiners who denied the reexamination request.

The standard for instituting *inter partes* review is set forth in 35 U.S.C. § 314(a) which provides:

THRESHOLD -- The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

RIM challenges the patentability of claims 1-12 on the basis of the following items of prior art:

US 7,123,936 (Rydbeck)	October 17, 2006	Ex. 1002
US 5,959,945 (Kleiman)	September 28, 1999	Ex. 1007
US 6,006,117 (Hageltorn)	December 21, 1999	Ex. 1003
US 5,422,656 (Allard)	June 6, 1995	Ex. 1006
Int. Pub. WO97/28649 (Salomäki)	August 7, 1997	Ex. 1004
RealPlayer Plus 4.0 Manual, Progressive Networks, Inc. (1997) (RealPlayer)		Ex. 1005

RIM asserts these grounds of unpatentability:

1. Claims 1-5 and 7-11 under 35 U.S.C. § 103 as obvious over Rydbeck, Hageltorn, Salomäki, and RealPlayer.
2. Claims 6 and 12 under 35 U.S.C. § 103 as obvious over Rydbeck, Hageltorn, Salomäki, RealPlayer, and Allard.
3. Claims 1-5 and 7-11 under 35 U.S.C. § 103 as obvious over Rydbeck, Hageltorn, Kleiman, and RealPlayer.
4. Claims 6 and 12 under 35 U.S.C. § 103 as obvious over Rydbeck, Hageltorn, Kleiman, RealPlayer, and Allard.

THE INVENTION

The invention of the '048 patent relates to “a mobile communication apparatus for carrying out communication through radio waves” and “an information providing system using the mobile communication apparatus.” (Ex. 1001, 1:9-14.) The specification of the '048 patent describes that for wireless mobile communication apparatus, audio communication is mainstream, but there is an increasing need for “composite and multiple data communication of character information, image information, video information, or the like.” (Ex. 1001, 1:22-28.) In the Background section, the specification describes that a user of a mobile communication apparatus often carries, in addition, a portable sound device for reproducing music data recorded on a magnetic tape, an optical disc, a magneto-optical disc, or the like, or a portable radio receiver for receiving AM broadcasting, FM broadcasting, TV sound, or the like. (Ex. 1001, 1:36-43.) In the Summary section, the specification states (Ex. 1001, 1:48-58):

In view of the fact that usage efficiency of a mobile communication apparatus is not absolutely high, and a user carries a portable sound device, a portable radio receiver, or the like in addition

to the mobile communication apparatus, an object of the present invention is to provide a mobile communication apparatus and an information providing system using the mobile communication apparatus in which the functions of these devices are combined so that the user of the mobile communication apparatus can obtain information of desired contents at a desired time without additionally carrying other devices.

The claimed invention requires reproducing and outputting downloaded data when the apparatus is in a “standby” state. Claims 1 and 7 are the independent claims. Claim 1 is directed to a mobile communication apparatus, and claim 7 is directed to an information providing system comprising a mobile communication apparatus. Both claims 1 and 7 include this whereby clause:

whereby said mobile communication apparatus is operable to reproduce and output downloaded data when said apparatus is in a **stand-by state**.

(Emphasis added.)

With regard to stand-by state, the specification of the '048 patent describes (Ex. 1001, 1:29-35):

Although a conventional mobile communication apparatus is normally used while being carried by a user, it can not [*sic*] be absolutely said that a time actually used by the user is long. That is, normally, the mobile communication apparatus is in the **state of stand-by** for almost [all] of the time used, and a ratio of time when communication is actually carried out is not absolutely high.

(Emphasis added.)

The entirety of claim 1 is reproduced below:

1. A mobile communication apparatus, comprising:
 - a) communication means for transmitting and receiving information signals to and from a base station via radio waves; said

base station further transmitting and receiving information signals to and from a service provider through a public line network;

b) input/output means for a user to interact with said mobile communication apparatus; said input/output means comprising a keypad, display means, a speaker, and a microphone;

c) a removable semiconductor memory for storing received information signals; and

d) processing means for encrypting the information signals prior to storage in said memory means;

whereby said mobile communication apparatus is selectively operable to perform one of the operations of outputting received information signals at the time of reception, storing received information signals for output at a later time, and simultaneously outputting and storing received information signals; and

whereby said mobile communication apparatus is operable to reproduce and output downloaded data when said apparatus is in a stand-by state.

DISCUSSION

A. Preliminary Matters

Prior Denial of Ex Parte Reexamination Request

At the outset, the patent owner notes that the Board in determining whether to institute review should carefully consider the denial of the *ex parte* reexamination request by a three-examiner panel. (Prel. Resp. 5:17-19.) The patent owner further notes that the three-examiner panel, in its order denying the reexamination request, already explicitly considered Rydbeck and Hageltorn with respect to the claim limitation of “operable to reproduce and output downloaded data when said apparatus is in a stand-by state” and that petitioner also is relying on Rydbeck and Hageltorn to meet that limitation. (Prel. Resp. 6:4-9.)

We appreciate the information provided by the patent owner. Prior consideration by examiners of the same claim feature based on the same prior art certainly should be considered, and we have given it consideration. Nonetheless, the patent owner should not expect that the Board necessarily would come to the same conclusion. Title 35, United States Code, Section 325(d) states:

In determining whether to institute or order a proceeding under . . . chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

The statutory provision does not require the Director, in deciding whether to institute *inter partes* review, to defer to a prior determination in the Patent and Trademark Office, even one which considered the same prior art and arguments. The statute gives the Director the authority not to institute review on the basis that the same or substantially the same prior art or arguments were presented previously to the Patent and Trademark Office, but does not require that result.

The patent owner argues that the petitioner does not explain why the reexamination examiners were wrong in denying the request for *ex parte* reexamination or why the order denying the request for *ex parte* reexamination should be reconsidered. (Prel. Resp. 6:9-10.) That argument is misdirected. A petition for *inter partes* review is not a renewed request for patent reexamination, an appeal of a prior decision denying a request for reexamination, or a rehearing request of the prior decision denying a request for reexamination. The petitioner correctly did not present its petition in any one of those ways. The patent owner should also refrain from treating the petition as a renewed request for reexamination, an appeal of a prior decision denying a request for reexamination, or a rehearing request of the prior decision denying a request for reexamination.

Alleged Violation of the Page Limit for Petition

The patent owner also asserts that the petition for *inter partes* review should be denied because the petition exceeds the sixty (60) page limit provided for an *inter partes* review petition under 37 C.F.R. § 42.24(a)(i). That assertion was made even though the corrected petition (Paper 7) is only forty (40) pages in length. The patent owner notes that the declaration of David R. Cuddy (Ex. 1008) relied on in the petition is twenty-nine (29) pages in length and then explains as follows (Prel. Resp. 18:18-19:1):

The Petitioners attach Mr. Cuddy's declaration as an exhibit, and then effectively incorporate it by reference into the Corrected Petition. As a result, the Petitioners submitted 69 pages of material [40 page petition plus 29 page declaration] advocating their position, even though they are only entitled to 60 pages. Moreover, the Corrected Petition runs afoul of the rule prohibiting incorporating by reference or combining arguments from one document into another. [37 C.F.R. § 42.6(a)(3)]

However, the petitioner has not incorporated by reference Mr. Cuddy's declaration into the petition. The patent owner has not identified any incorporation by reference language in the petition.

The patent owner also asserts that David R. Cuddy's declaration is "effectively" incorporated by reference, even though incorporation by reference is prohibited by 37 C.F.R. § 42.6(a)(3). (Prel. Resp. 20:4-7.) That assertion is misplaced. Declaration testimony generally is regarded as evidence, not argument. The factual portions of the declaration, if identified with sufficient specificity, must be considered, and argumentative portions, together with the unidentified factual portions, need not be considered. There is no meaningful occasion to consider whether a declaration has been "effectively incorporated by reference." Impermissible incorporation by reference usually applies to non-evidentiary papers

such as remarks accompanying an amendment, a response to a rejection or petition, a companion motion, opposition, or reply, another petition, a memorandum, an appellate brief, or any other submission advocating a certain position.

The declaration testimony of David R. Cuddy properly is labeled as an exhibit and it is the proper role of a declaration exhibit to be referred to in a petition as evidence in support of the petition. The pages of an exhibit are not included in the page count of the petition. It appears the patent owner contends that this case represents an extraordinary circumstance in which the pages of the declaration should be added to the pages of the petition, *i.e.*, the declaration testimony contains numerous arguments in addition to factual support for arguments made in the petition. For several reasons, we decline to take that unusual step here.

First, the patent owner has not identified separately the factual portions of the declaration apart from the argument portions and thus has not established that the argument portion exceeds twenty (20) pages. Note that the petition is only forty (40) pages in length and can absorb another twenty (20) pages without exceeding the sixty (60) page limit. Secondly, if petitioner omits certain arguments in the petition, petitioner does that at its own risk because it is possible that the Board would not consider arguments not made in the petition. Third, but not the least, if a party has an objection about the other party's exceeding a certain page limit, the matter should be raised as soon as possible with the Board to preserve remedial measures which can still be taken by the Board without prejudice to all parties. We disapprove of the patent owner's taking three months to make the procedural objection and to ask that the petition be denied on that basis.

The patent owner further argues that because the petition and the declaration of David R. Cuddy often cite to different portions of the '048 patent and the applied prior art, that increases “the depth of the argument without a corresponding increase in the pages of the Corrected Petition.” (Prel. Resp. 23:6-16.) The argument is misplaced, as there is no requirement that a supporting declaration only cite to evidence which has already been directly cited in the petition.

B. Claim Interpretation

In determining patentability over the prior art, the name of the game is the claim. *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998). Consistent with the statute and the legislative history of the AIA, the Board interprets claim terms by applying the broadest reasonable construction in the context of the specification in which the claims reside. 37 C.F.R. § 42.100(b); *see* Office Patent Trial Practice Guide, 77 *Fed. Reg.* 48756, 48766 (Aug. 14, 2012).

We give claim terms their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the entire patent disclosure. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005)(en banc). That ordinary and customary meaning applies unless the inventor as a lexicographer has set forth a special meaning for a term. *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998); *York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1572 (Fed. Cir. 1996). When an inventor acts as a lexicographer, the definition must be set forth with reasonable clarity, deliberateness, and precision. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998). The Patent Owner has not alleged that the inventors acted as their own lexicographer and gave any claim term a special definition different from its recognized meaning to one with ordinary skill.

In this case, analysis of the unpatentability assertions depends on the meaning of the claim term “stand-by state” in the context of the ’048 patent. The “stand-by state” recited in independent claims 1 and 7 is that of the mobile communication device. As we have determined above, the specification of the ’048 patent identifies audio communication as “mainstream” in conventional mobile communication devices.

Also as we have determined above, the specification of the ’048 patent states (Ex. 1001, 1:29-35):

Although a conventional mobile communication apparatus is normally used while being carried by a user, it can not [sic] be absolutely said that a time actually used by the user is long. That is, normally, the mobile communication apparatus is in the **state of stand-by** for almost [all] of the time used, and a ratio of time when communication is actually carried out is not absolutely high.

(Emphasis added.)

The above-quoted text indicates (1) that a mobile communication device in the context of patent owner’s invention is not actually being used very long, although it is normally deemed to be used while carried by the user, and (2) that while the device is used by not “actually” used, it is in a stand-by state. That alone does not provide a clear meaning because what constitutes “use” and “actual use” is not yet known and the distinction between them is uncertain. But we also determined above that the specification of the ’048 patent describes that for wireless mobile communication apparatus, audio communication is mainstream. (Ex. 1001, 1:22-28.) In light of such disclosure, one with ordinary skill would have known that if the mobile communication device was a cellular phone, then when a user is actively communicating on a connected line, that would reflect actual use, and when the phone is powered on and not supporting active

communication on a connected line, but capable of receiving a call or initiating an outgoing call, that would be operation in a stand-by state. If the mobile communication apparatus was not a cellular telephone but only a data communication device, the same would be true, *i.e.*, stand-by state refers to a state in which the device is powered on and ready to transmit or receive without actual transmission of substantive data.

The above represents the broadest reasonable interpretation of “standby state” in the context of the ’048 patent. That is essentially the same as the interpretation urged by petitioner. The petitioner asserts (Pet. 4:20 to 5:3):

The term “stand-by state,” in view of the ’048 patent specification, refers to a mobile communication apparatus or cellular phone that is powered on to receive calls but not currently engaged in an ongoing call. (Ex. 1008, Cuddy Decl. ¶ 17.)

The only difference between our interpretation and petitioner’s is our recognition that the claimed mobile communication apparatus is not limited to a cellular telephone but covers mobile communication apparatuses, which do not make or receive telephone calls and therefore a construction limited to calls is too narrow. Petitioner’s interpretation is correct as applied to a cellular telephone.

The patent owner states in its preliminary response that it “takes no position on the correct claim interpretation for this claims element [stand-by state] at this time.” (Prel. Resp. 12:7 n.4.) Given that the patent owner takes no position on the correct interpretation for “stand-by state,” we discuss nothing more, except to note that we are aware of the interpretation accorded the term during reexamination. As to the patent owner’s argument that petitioner does not explain why its proposed interpretation is correct over that of the reexamination examiners and that the petitioner does not explain why the reexamination examiners’ interpretation is incorrect, it suffices to say that this *inter partes* review is neither a continued

prosecution of the previous reexamination proceeding nor an appeal therefrom. We see nothing wrong with the approach and strategy adopted by the petitioner.

Both independent claims 1 and 7 recite this whereby clause: “whereby said mobile communication apparatus is selectively operable to perform one of the operations of outputting received information signals at the time of reception, storing received information signals for output at a later time, and simultaneously outputting and storing received information signals.”

C. Claims 1-5 and 7-11 as Obvious over
Rydbeck, Hageltorn, Salomäki, and RealPlayer

Rydbeck is the primary reference supporting this alleged ground of unpatentability.

Rydbeck

Rydbeck discloses a cellular telephone including a built-in digital entertainment module 50 which allows music to be played back through the cellular phone’s headset 40. (Ex. 1002, 3:41-44.) The entertainment module 50 includes a RAM 54 and/or removable memory cartridges for storing music which can be played back through the headset. (Ex. 1002, 3:44-48.) The entertainment module 50 has a removable ROM 56 preferably in the form of a cartridge which fits into a slot on transceiver 12. (Ex. 1002, 3:50-52, 60-62.) ROM cartridge 54 would contain pre-recorded music. (Ex. 1002, 3:62-63.)

The cellular phone also includes a keypad 30 and a display 32 for providing user interface. (Ex. 1002, 3:20-21.) Headset 40 includes stereo speakers 42 and microphone 44 which are connected to transceiver 12 by a cable 46. (Ex. 1002, 3:29-31.) Playback of audio from within the RAM or removable ROM is performed under the control of microprocessor 20. (Ex. 1002, 4:9-11.) It is also

described that audio can be obtained from transceiver 12 in an “internet enabled” phone. (Ex. 1002, 3:58-60.)

Additionally, it is the testimony of David R. Cuddy (Ex. 1008, ¶ 41) that at the time of the invention of the ’048 patent, (1) it was well understood by one with ordinary skill in the art that a cellular phone communicates with a base station, and (2) for an “internet-enabled” cellular phone, it was well understood by one with ordinary skill in the art that the base station communicates with an internet service provider by using a uniform resource locator URL.

Rydbeck further describes that microprocessor 20 controls the routing of audio signals between the entertainment module 50 and audio processing circuits 24. (Ex. 1004, 4:56-59.) David R. Cuddy testifies that Rydbeck’s microprocessor 20 controls the storage and playback of audio information to and from memory in entertainment module 50. (Ex. 1008, ¶ 38.)

Rydbeck does not expressly describe a “stand-by state” for its cellular phone. However, it implicitly describes a “stand-by state” through the following description (Ex. 1002, 4:12-24):

When an incoming call is received, the microprocessor 20 automatically mutes or stops the playback of audio from the digital entertainment module 50 until the call is terminated. . . . Upon termination of the call, the microprocessor 20 would unmute or restart the playback of audio from the digital entertainment module 50.

The above-quoted description indicates that Rydbeck’s cellular phone 10 has a mode of operation in which power is turned on, no call is currently engaged or connected, but the cellular phone is ready to receive an incoming call, which meets the requirement of a “stand-by state.”

Hageltorn

Hageltorn discloses wireless mobile phones which communicate with base stations to support incoming and outgoing calls, and each base station is connected to the public wired telecommunication network. (Ex. 1003, 1:35-38.) Hageltorn discloses two modes of operation for such a wireless mobile phone. (Ex. 1003, 1:40-42.) The first mode refers to operation during ongoing calls involving intense communication between the mobile phone and the base station. (Ex. 1003, 1:42-44.) The second mode is a standby mode. Specifically, Hageltorn states (Ex. 1003, 1:45-67):

The second mode of operation is the **stand-by mode**, i.e., **when the mobile station is not serving any ongoing call, a certain communication with the base station, however, [is] still occurring at a regular basis**. For instance, when the user turns on his mobile station, the mobile station will search for available base stations and select the one with the highest signal strength. Then the mobile station reports its presence to the selected base station. The mobile station will then regularly receive information from the base station, for instance frequency synchronization information. If the signal strength turns out to be lower than the signal strength of any other available base station, a switch to the latter normally occurs (so-called hand-over). Furthermore, a bidirectional so-called handshake communication takes place between the mobile station and the base station, when an incoming call is to be established. Thanks to the above it is possible to provide services like roaming (the system detects and keeps record of subscribers for the moment being abroad), SMS (Short Message Services; transmission of short text message to be presented on the telephone display), and CB (Cell broadcast; broadcast messages from, e.g. a public authority to several mobile telephones present in a cell).

(Emphasis added.)

It is evident that the certain signals still communicated to and from a base station in the stand-by mode are for allowing the phone to initiate an outgoing call

or to receive an incoming call. Such a stand-by mode is fully consistent with our interpretation of stand-by mode as indicated above.

Salomäki

Salomäki describes that because digital recordings are easily duplicated (Ex. 1004, 2:4-8):

[T]here has arisen a need to encrypt, or scramble, the objects in connection with transmission and storage so that their reception and reproduction without a permission from their copyright owners be as difficult as possible. The purpose of this arrangement is that the producer and/or distributor of an object get a certain remuneration from the receiver and/or user.

Salomäki further states that an object of its invention is to provide a method for scrambling and descrambling electronically transmitted objects, covering the transmission, reception, storing and reproduction of objects. (Ex. 1004, 3:8-10.)

With regard to terminal equipment that receives digital recordings, Salomäki refers to “GSM mobile telephone system” (Ex. 1004, 2:13-15) and states (Ex. 1004, 3:33-38):

The invention is also directed to terminal equipment for receiving, storing and reproducing digital media objects to a user, said terminal equipment comprising means for descrambling the scrambled broadcast format. The terminal equipment according to the invention is characterized in that it further includes means for storing a received media object in a scrambled storage format which is different from said scrambled broadcast format.

Salomäki describes that “[d]evices handling digital media objects are manufactured such that they can reproduce a received or stored object only if they have at their disposal the key that authorizes the reproduction of the object in question.” (Ex. 1004, 4:7-9.)

Salomäki is relied on by petitioner to meet the claim feature in both independent claims 1 and 7 of “processing means for encrypting the information signals prior to storage in said memory means.” Citing the prosecution history of the '048 patent, petitioner asserts that during prosecution the patent owner did not deny that Salomäki describes encrypting content stored in a GSM mobile telephone. (Pet. 9:4-6.) That assertion is not challenged by the patent owner.

RealPlayer

RealPlayer discloses a RealPlayer™ Plus 4.0 software that enables listening and viewing of live and pre-recorded clips of sporting events, radio broadcasts, news, music, and lectures. (Ex. 1005, 4:1-8.) The page numbers we use in our citation to RealPlayer are the numbers on the bottom right corner of each page below the designation “RIM Exhibit 1005.”

RealPlayer provides a user the option of recording a clip during playback or recording a clip prior to playback. (Ex. 1005, 21-22.) There exists a record button the function of which is “to record the clip currently being played.” (Ex. 1005, 12; Fig. 2.) Petitioner relies on RealPlayer’s teachings to meet the feature in both independent claims 1 and 7 of “outputting received information signals at the time of reception,” and “simultaneously outputting and storing received information signals.” (Pet. 17:14 to 18:7.)

* * *

We have considered the arguments and evidence presented by petitioner and determine that there is a reasonable likelihood that petitioner would prevail on this alleged ground of unpatentability for each of claims 1-5 and 7-11.

Petitioner relies on Hageltorn for its disclosure of a stand-by state for a wireless telephone, and asserts that it would have been obvious to one with ordinary skill in the art, in light of Hageltorn’s disclosure of a stand-by state for a

wireless telephone, to implement a similar stand-by state in Rydbeck's cellular telephone. We agree with petitioner's rationale. However, as we discussed above, Rydbeck's cellular telephone 10 itself implements a stand-by state. Reliance on Hageltorn is not necessary to meet the requirements relating to a stand-by state.

The patent owner relies on the conclusion of the reexamination examiners during the prior reexamination proceeding of the '048 patent that Rydbeck does not expressly disclose a stand-by state for its cellular telephone 10. (Prel. Resp. 10:22-11:3.) It is true that Rydbeck does not explicitly refer to a stand-by state. But as we determined above, Rydbeck implicitly describes a stand-by state for its cellular telephone 10. In that regard, Rydbeck states (Ex. 1002, 4:12-24):

When an incoming call is received, the microprocessor 20 automatically mutes or stops the playback of audio from the digital entertainment module 50 until the call is terminated. . . . Upon termination of the call, the microprocessor 20 would unmute or restart the playback of audio from the digital entertainment module 50.

As we determined above, the above-quoted description indicates that Rydbeck's cellular phone 10 has a mode of operation in which power is turned on, no call is currently engaged or connected, but the cellular phone is ready to receive an incoming call, which meets the requirement of a "stand-by state." In any event, we agree with petitioner that it would have been obvious to implement a stand-by state for Rydbeck's cellular telephone in light of Hageltorn's explicit discussion of the use of a stand-by state in Hageltorn's wireless mobile telephone.

The patent owner also relies on the conclusion of the reexamination examiners during the prior reexamination proceeding of the '048 patent that even assuming that Rydbeck's cellular telephone 10 has a stand-by state, Rydbeck does not disclose the patent owner's claimed feature of "operable to reproduce and output downloaded data when said apparatus is in a stand-by state." (Prel. Resp.

10:22-11:3.) The patent owner quotes the following statement of the reexamination examiners (Prel. Resp. 10:17-20):

Rydbeck merely teaches that playback of audio is muted during an incoming call. Such a disclosure fails to imply playback during a time during which the call is terminated.

Rydbeck does not merely teach that playback of audio is muted during an incoming call. It is described that “[w]hen an incoming call is received, microprocessor 20 automatically ‘mutes or stops’ the playback of audio from the digital entertainment module 50 until the call is terminated.” (Ex. 1002, 4:12-15.) The description implies an operative circumstance in which reproduced audio is playing and the phone is powered on and ready to receive an incoming call. That satisfies the claim feature of “whereby said mobile communication apparatus is operable to reproduce and output downloaded data when said apparatus is in a stand-by state.” With regard to the second sentence of the above-quoted text, we note simply that Rydbeck also describes (Ex. 1002, 4:22-24): “Upon termination of the call, the microprocessor 20 would unmute or restart the playback of audio from the digital entertainment module 50.”

For the foregoing reasons, we conclude that there is a reasonable likelihood that petitioner would prevail on its assertion that claims 1-5 and 7-11 are unpatentable over Rydbeck, Hageltorn, Salomäki, and RealPlayer under 35 U.S.C. § 103.

D. Claims 6 and 12 as Obvious over
Rydbeck, Hageltorn, Salomäki, RealPlayer and Allard

Claims 6 and 12 depend on claims 1 and 7, respectively. Each of claims 6 and 12 includes this wherein clause:

wherein said display means comprises a liquid crystal display (LCD) having a touch sensing screen, whereby the user can input information signals by touching said touch sensing screen.

Petitioner relies on Allard to meet the above-quoted additional limitation, relative to the subject matter of independent claims 1 and 7 which petitioner asserts are unpatentable over Rydbeck, Hageltorn, Salomäki, and RealPlayer.

Allard

Allard discloses a personal communicator 10 which includes a cellular phone and a data processing system. (Ex. 1006, 3:28-30.) A touchscreen display device is mounted on the casing and serves as an input/output device and user interface for entering and receiving information from the personal communicator. (Ex. 1006, 3:45-50.) The touchscreen display includes a touch sensitive overlay 28 which overlies a liquid crystal display 38 and a backlight. (Ex. 1006, 3:68 to 4:3.)

* * *

We have reviewed petitioner's arguments on why in light of the disclosure of Allard, one with ordinary skill in the art would have known to employ on the cellular phone 10 of Rydbeck the touchscreen display of Allard. On this record, the argument has merit and is persuasive. The patent owner has not presented persuasive argument and evidence to the contrary.

Accordingly, we conclude that there is a reasonable likelihood that petitioner would prevail on its assertion that claims 6 and 12 are unpatentable over Rydbeck, Hageltorn, Salomäki, RealPlayer, and Allard under 35 U.S.C. § 103.

E. Claims 1-5 and 7-11 as Obvious over
Rydbeck, Hageltorn, Kleiman, and RealPlayer

Kleiman

Kleiman describes a method and apparatus for distributing music to local, digital, electronic jukeboxes. (Ex. 1007, Abstract:1-2.) In one embodiment, the jukebox is an intelligent terminal which includes a CPU hardware box, a massive storage system large enough to store more than 200 compressed songs, and a real time operating system and drivers for the hardware devices. (Ex. 1007, 6:41-42; 6:60-65.) Kleiman describes that in its inventory of electronic titles each is digitally encoded into a secure digital envelope to be used for mail distribution or electronic transmission or storage and can only be opened by authorized users. (Ex. 1007, 6:1-4.) Kleiman further describes (Ex. 1007, 12:34-37): “In the security system of the present invention, the songs in each jukebox are stored in an encrypted format which prevents them from being transferred to another jukebox or other storage medium.” Like Salomäki, Kleiman is relied on by petitioner to meet the claim feature in both independent claims 1 and 7 of “processing means for encrypting the information signals prior to storage in said memory means.”

* * *

Petitioner’s assertion of unpatentability based on Rydbeck, Hageltorn, Kleiman, and RealPlayer is as good as its assertion of unpatentability based on Rydbeck, Hageltorn, Salomäki, and RealPlayer as we have already discussed above. Kleiman’s teaching of encrypting stored music is as good as, if not stronger, than that of Salomäki, and Kleiman is no less combinable with the other applied references than is Salomäki.

We conclude that there is a reasonable likelihood that petitioner would prevail on its assertion that claims 1-5 and 7-11 are unpatentable over Rydbeck, Hageltorn, Kleiman, and RealPlayer under 35 U.S.C. § 103.

F. Claims 6 and 12 as Obvious over
Rydbeck, Hageltorn, Kleiman, RealPlayer, and Allard

Claims 6 and 12 depend on claims 1 and 7, respectively. Each of claims 6 and 12 includes this wherein clause:

wherein said display means comprises a liquid crystal display (LCD) having a touch sensing screen, whereby the user can input information signals by touching said touch sensing screen.

Petitioner relies on Allard to meet the above-quoted additional limitation, relative to the subject matter of independent claims 1 and 7 which petitioner asserts are unpatentable over Rydbeck, Hageltorn, Kleiman, and RealPlayer. The teaching of Allard has already been discussed above. We conclude that there is a reasonable likelihood that petitioner would prevail on its assertion that claims 6 and 12 are unpatentable over Rydbeck, Hageltorn, Kleiman, RealPlayer, and Allard under 35 U.S.C. § 103.

ORDER

It is

ORDERED that the petition is *granted* as to claims 1-5 and 7-11 of the '048 patent on the alleged ground of obviousness over Rydbeck, Hageltorn, Salomäki, and RealPlayer under 35 U.S.C. § 103;

FURTHER ORDERED that the petition is *granted* as to claims 6 and 12 of the '048 patent on the alleged ground of obviousness over Rydbeck, Hageltorn, Salomäki, RealPlayer, and Allard under 35 U.S.C. § 103;

FURTHER ORDERED that the petition is *granted* as to claims 1-5 and 7-11 of the '048 patent on the alleged ground of obviousness over Rydbeck, Hageltorn, Kleiman, and RealPlayer under 35 U.S.C. § 103;

FURTHER ORDERED that the petition is *granted* as to claims 6 and 12 of the '048 patent on the alleged ground of obviousness over Rydbeck, Hageltorn, Kleiman, RealPlayer, and Allard under 35 U.S.C. § 103;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), a trial for *inter partes* review of the '048 patent is hereby instituted, commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of trial;

FURTHER ORDERED that the trial is limited to the above-stated grounds of obviousness on the above-stated claims, and that no other ground for any claim is authorized for trial; and

FURTHER ORDERED that an initial conference call with the Board is scheduled for 3 PM ET on April 1, 2013; the parties are directed to the Office Trial Practice Guide, 77 Fed. Reg. 48756, 48765-66 (Aug. 14, 2012) for guidance in preparing for the initial conference call, and should come prepared to discuss any proposed changes to the Scheduling Order entered herewith and any motions the parties anticipate filing during the trial.

IPR2013-00036
Patent 6,871,048

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